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Paper No. 8

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OFFICE OF PETITIONS

In re Application of	:
Donald L. Schilling	:
Application No. 09/843,520	: DECISION REFUSING STATUS
Filed: 27 April, 2001	: UNDER 37 CFR 1.47(b)
Attorney Docket No. 1-2-32.3US	:

This is in response to the petition under 37 CFR 1.47(b) filed on 21 September, 2001.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 27 April, 2001, without an executed oath or declaration.

Accordingly, on 20 June, 2001, a "Notice To File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on 21 September, 2001 (certificate of mailing date 20 September, 2001), the present petition and authorization to charge the petition fee to counsel's deposit account, No. 09-0435 were filed, accompanied by, *inter alia*, a request and payment of the fee for a one (1) month extension of the time to reply to the "Notice" and a declaration naming Donald L. Schilling as the sole inventor and signed by Donald M. Boles, Vice President - Intellectual Property for InterDigital Technology Corporation on behalf of the non-signing inventor, an employment agreement between inventor Schilling and International Mobile Machines Corporation (IMM) (by change of name InterDigital Technology Corporation (IDTC)), and a declaration by petitioner's registered patent attorney, Jeffrey M. Glabicki.

Petitioners state that a copy of the application papers were sent to Schilling. Petitioners' counsel states that the inventor subsequently orally refused to sign the declaration during a telephone call with counsel. In the employment agreement between Schilling and IMM, it is stated, to wit, that Schilling agrees to assign to IMM all inventions discovered, created or developed during the term of his employment and within the scope of his employment. Further, the declaration of Jeffrey M. Glabicki, petitioner's registered patent counsel, states that IMM changed its name to IDTC, and that Schilling is contractually obligated by the employment agreement to assign the invention which is the subject of the present application for patent to IDTC.

A grantable petition under 37 CFR 1.47(b) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a statement of the last known address of the non-signing inventor;
- (5) proof of proprietary interest, and
- (6) proof of irreparable damage.

The petition lacks items (1), (2), and (6). In regards to item (1), petitioner has not provided sufficient proof that a copy of the application (specification including claims, drawings, if any, and the Declaration) was sent or given to the non-signing

inventor for review.¹ In this respect, it is noted that although the petition states that a copy of the letters transmitting the application to the non-signing inventor at the inventor's last known address is enclosed with the petition, no cover letters have been located among the papers filed with the present petition on 21 September, 2001. Furthermore, it is not apparent from the declaration of attorney Glabicki whether Glabicki was the person who sent (*i.e.* had first-hand knowledge) the application to Schilling.

Petitioner should submit a copy of the cover letter transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person with first-hand knowledge of the details.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 has not been presented. The declaration under 37 CFR 1.63 and 1.64 does not set forth the citizenship, residence, and mailing address of Mr. Boles (signing on behalf of IDTC, the putative party having proprietary interest). Attention is directed to 37 CFR 1.63(a)(3); MPEP §§ 605.02, 605.03. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 is required.²

In regards to item (5), petitioner must provide proof of irreparable damages in accordance with MPEP 409.03(g).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
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¹MPEP 409.03(d).

²See MPEP 409.03(b).

Telephone inquiries related to this decision should be directed to the undersigned at (703)308-6918.



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for Patent Examination Policy